

No. 19,725

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

WESTERN LIGHTING CORP.,

Appellant,

vs.

SMOOT-HOLMAN,

Appellee.

Petition for Rehearing on Behalf of Appellant,
Western Lighting Corp.

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To the Honorable Ben C. Duniway; Walter Ely, Circuit Judges of the United States Court of Appeals for the Ninth Circuit and Walter E. Craig, District Judge:

The appellant above-named aggrieved by the opinion filed in this court on December 7, 1966, comes now and respectfully petitions for a rehearing relative to the questions presented herein.

1. Page 2 of the opinion,—there were *not* “several awards.”

2. At page 3, Finding of Fact 15 *was* contested. (Pages 3 and 4 Reply Brief.)

3. At page 3—the *record* has no bearing on invalidity under Sec. 112. The undefined “relatively narrow,” and undefined *spacing, per se*, render the claims invalid, particularly where plaintiff *apparently relies on these things for patentability.*

The Fixture of Finding of Fact 11 Was Not Experimental.

No witness testified that the display fixture of Finding of Fact 11 was experimental. Plaintiff assumed no such burden at all.

There are no *Findings* of Fact supporting the conclusion that said display was experimental.

At the bottom of page 2, of this Court's opinion, the law of the case of *Amerio Contact Plate Freezers v. Belt-Ice Corporation*, 316 F. 2d 459, is wrongly applied. It is clear from the evidence, that the display fixture in the offices of Smoot and Holman satisfies the requirements of this case, as stated at page 465, as follows:

"Ordinarily, however, selling activity (at least activity short of actual sales) prior to the time that a *fully operative article or apparatus incorporating the invention comes into existence*, it is not a reliable indicium of competitive exploitation. Until at least *an operative prototype has been completed and tested*, the competitive effectiveness of such activity, in all probability, will be impaired by the aura of continuing developmental, experimental and testing effort." (*Italics added*).

It is respectfully, but emphatically submitted, that the evidence leaves no doubt that the display installation in the offices of Smoot and Holman was a *fully operative and successful prototype*.

The design work done on the large installation at Air Research by Bill Jones and the installation in the Photometric Lab obviously do not make the display installation of Finding of Fact 11 experimental. The case of *Tucker & Aluminum Products, Inc. v. Grossman*, 312 F. 2d 293, CA 9, January 9, 1963, is cited

in the opinion, but in this case the *defense of prior public use was held to be good*, the Court stating, “further the contentions of plaintiff pertaining to testing and experimentations are without merit.”

This Court’s Decision Is Incorrect Because the Findings of Fact Are Spurious and Insufficient and Cannot Support the Holding of Validity; What Is Found to Be Patentable Is Not in the Claims; the Claims Are Obvious in View of the Prior Art.

Finding of Fact number 61 found the combination of features to be a new element comprising:

- a. relatively long narrow lamp housings generally rectangular in cross section;
- b. open at the top and bottom with opaque sides,
- c. containing wireways;
- d. to be engaged end-to-end with the wireways aligned and connected.

No Claim in Suit Contains This Combination of Features.

Claim 1 is *not limited to a relatively narrow fixture*; it is limited only to narrow vertical *outer* side members; it is a fixture of *any* width. It is *NOT* open at the top and bottom.

Claims 9 and 10 do not include any wireways at all; there are no inner side walls. The *sides* of claim 10 are not vertical.

Claim 12 is NOT limited to a narrow clamp housing. This claim is simply two housings end-to-end. The housing side walls are *parallel, not vertical*.

The record shows that the trial judge, at the end of the trial, did not know what was offered as new or relied upon which amounts to invention. The trial court and this court have been misled. *The question still remains unanswered:*

It is necessary that findings show *what is patentable over the prior art.*

Yavitch v. Seewack, 323 F.2d 561; CA 9, 1963.

Even the spurious Findings of Fact on record in the case at bar do not state what is different over the prior art.

Findings of Fact numbers 59 and 60 in the case at bar relating to a patentable combination are mere conclusions of law and cannot support the court's decision.

See *Welsh Co. of California v. Strollee of California*, CA 9, April 28, 1961. 290 F. 2d 509.

The above case was again brought before this court at 313 F.2d 923, February 14, 1963 and the patent was held invalid just as should be done in the case at bar.

Findings must be detailed and complete in respect to prior art, time of invention, the existence of competing machines, nature of competing machines and comparison of functions, in short, novelty, utility and invention. There is absolutely no support in the Findings or elsewhere for the conclusion in Finding 11 that the display fixture was "experimental."

See,

Kaakinen et al v. Peelers Co., CA 9, 133 USPQ 298 April 10, 1962.

How can the alleged advantages of Finding 15 flow from the claims upon honestly acknowledging what is *NOT* in them!

Claim 9 does not *exclude* a longitudinal wire way and ballast support between the housings.

Considering claims 1, 9, 10 and 12 rather than the *spurious* Finding 61, they are *obvious* as follows.

Claim 12 (Ex. B1)—Beck patent No. 2,312,617 Ex. P. British patent No. 570,042 Ex. N.

Claim 1 (Ex. BE)—Same, plus Strang patent No. 2,090,239 Ex. AO (alone or combined)

Claim 10 (Ex. BH)—Kantack patent No. 2,306,700 Ex. AQ. Ainsworth design patent No. 169,999 Ex. Q with Architectural Forum Ex. AL. Ruby Lighting Fixture Ex. Y and Ex. X (p. 3) in view of Exs. AQ and Q.

Claim 9 (Ex. BF)—Same as claim 10, Ex. Y taken alone. (Ex. X (page 3)) is a photograph of this fixture.

The claims are invalid under Sec. 112.

Schriber-Schroth Co. v. Cleveland Trust Co.,
305 U.S. 46;

General Electric Co. v. Wabash Appliance Corp.,
304 U.S. 364;

United Carbon Co. v. Binney & Smith Co., 317
U.S. 228.

Note that in the *General Electric* case “comparatively large” was condemned on certiorari to this Court with respect to lamp filament granules. In the *United Carbon* case “comparatively small” was condemned.

It is strongly urged that a rehearing be granted in this case.

HERZIG, WALSH & BLACKHAM.

By EDWARD C. WALSH,

Attorneys for Appellant.

Certificate.

I hereby certify that in my judgment the petition for rehearing is well founded and further certify that it is not interposed for delay.

EDWARD C. WALSH,
Attorney for Appellant.